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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/639,611
Filing Date: August 12, 2003
Appellant(s): GELLER ET AL.

Timothy J. Bechen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 28, 2008 appealing from the Office
action mailed December 10, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is not contained in the brief. No assignment having been made, the inventors Steven Geller and Aaron Birnbaum are the real parties in interest.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 10 and 20 have been amended subsequent to the final rejection to address typographical errors previously noted by the Examiner. The Examiner has noted additional typographical errors in claims 21-26. The claims refer to "the method of claim 20" though claim 20 is a system claim. It is clear that this was intended to read "the computer system of claim 20."

Claims 1-9, 11, and 19 been canceled.

This appeal involves claims 10, 12-18, and 20-27.

(4) Status of Amendments After Final

The amendment after final rejection filed on July 25, 2008, has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The brief is deficient because the specification pages and line numbers referred to in support of many of the features set forth in the summary of claimed subject matter do not adequately support the claimed subject matter. The claimed subject matter is, however, supported elsewhere in the specification.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Deleted: The Examiner improperly rejects

I. Whether claims 10 and 20 are properly rejected under 35 U.S.C. §102(b) as being anticipated by Published Application No. 2001/0005829 (Raveis).

Deleted: because

Deleted: fails to identically disclose all of the claimed limitations, including the limitations the Examiner improperly overlooks as being wrongly characterized as non-functional descriptive material.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

20010005829

Raveis

6-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 10, 12-18, and 20-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Raveis (Paper #090105; Pub. No. US 2001/0005829).

Raveis teaches a system and method for facilitating real property transactions using a computer system comprising storing data identifying properties in at least one database, displaying deal information on a screen with, and allowing the user to select

information using actuatable buttons (see at least abstract, page 1 ¶ 0008). Raveis further discloses:

- storing realty data in a database: (see at least abstract); identifying a plurality of real properties including address data associated with each real property (see at least abstract, fig.3, page 1 ¶ 0003, page 9 ¶ 0098); deal data identifying a plurality of deals for mortgage refinancing previously closed on at least some of the real properties in the realty data (see at least page 2 ¶ 0019, page 4 ¶ 0047, page 7 ¶ 0084, 0086; page 8 ¶ 0092, 0094; page 9 ¶ 0096, 0098). Please note: as discussed in previous office actions, the exact information provided, not having any functional role in the method, is non-functional descriptive material. Because it has no functional role in the method this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106. In this case, however, the descriptive material in the present application is essentially the same as in Raveis);
- displaying on a computer display a deal information screen: including data obtained from the database (see at least Figs. 1,3-6; page 1 ¶ 0008, page 2 ¶ 0013, page 4 ¶ 0070, page 8 ¶ 0092, page 9 ¶ 0098);
- identifying one or more of the plurality of real properties: the deal information screen containing a first user actuatable button, a second user actuatable button, and a third user actuatable button (see at least page 1 ¶¶ 0008,0011; page 4

¶0039, page 8 ¶ 0091, page 9 ¶100, page 10 ¶ 0102-0105. Please note: as

discussed above, the form of the graphic icon is nonfunctional descriptive matter because it has no functional role in the method. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106. It could be a radio button, blue underlined text, another kind of button, all of which are common, or it could be any other graphic representation); displaying in the deal information screen a third user actuatable button, and in response to the user actuating the third actuatable button displaying additional information about the selected real property obtained from the database, wherein the additional information comprises mortgage data derived from a publicly available source and nonpublic, proprietary deal information, quote data representing one or more quotes for mortgage refinancing related to the selected real property, notes data representing notes entered by the user regarding an offer to refinance the mortgage on the selected real property, history data representing one or more events in the history of a deal associated with the selected real property, data representing tasks to be done related to a deal associated with the selected real property (see at least page 1 ¶ 0008, page 8 ¶ 0091, page 10 ¶ 0102-0105. Please note: as discussed above, the form of the graphic icon is nonfunctional descriptive matter because it has no functional role in the method. This descriptive material will not distinguish the claimed invention from the prior art in

terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106).

- allowing the user to select: one of the real properties displayed in the deal information screen (see at least page 3 ¶ 0033);
- in response to the user actuating the first user actuatable button: by a single user selection, searching the database for first deal data comprising one or more previously closed deals for mortgage refinancing at the same address as the selected real property, retrieving the first deal data, and displaying the first deal data on the computer display (see at least page 1 ¶ 0008, page 2 ¶ 0013, 0019, page 4 ¶ 0047, 0070; page 7 ¶ 0084, 0086; page 8 ¶ 0091, 0092, 0094; page 9 ¶ 0096, 0098; page 10 ¶ 0102-0105. Please note: as discussed above and in previous office actions, the exact information provided, not having any functional role in the method, is non-functional descriptive material. Because it has no functional role in the method this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106. In this case, however, the descriptive material in the present application is essentially the same as in *Raveis*);
- in response to the user actuating the second user actuatable button: by a single user selection, searching the database for second deal data comprising one or more previously closed deals for mortgage refinancing at addresses located on the same street as the first real property, retrieving the second deal data and

displaying the second deal data on the computer display (see at least page 1 ¶ 0008, page 2 ¶ 0013, 0019, page 4 ¶ 0047, 0070; page 7 ¶ 0084, 0086; page 8 ¶ 0091, 0092, 0094; page 9 ¶ 0096, 0098; page 10 ¶ 0102-0105. Please note: as discussed above and in previous office actions, the exact information provided, not having any functional role in the method, is non-functional descriptive material. Because it has no functional role in the method this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106. In this case, however, the descriptive material in the present application is essentially the same as in *Raveis*).

- in response to the user actuating the third actuatable button: by a single user selection, searching the database for additional information about the selected real property, retrieving the additional information, and displaying the additional information on the computer display (see at least page 1 ¶ 0008, page 2 ¶ 0013, 0019, page 4 ¶ 0047, 0070; page 7 ¶ 0084, 0086; page 8 ¶ 0091, 0092, 0094; page 9 ¶ 0096, 0098; page 10 ¶ 0102-0105. Please note: as discussed above and in previous office actions, the exact information provided, not having any functional role in the method, is non-functional descriptive material. Because it has no functional role in the method this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106. In this

case, however, the descriptive material in the present application is essentially the same as in Raveis);

- the user relating the first or second deal data to an offeree: that is responsible for the selected real property (see at least abstract, fig.7, pages 1-3 ¶¶ 0011-0013, 0018-0019, 0029-0030);
- an input device: (see at least fig.1, page 1 ¶¶ 0007-0008, page 4 ¶ 0040, page 8 ¶ 0091);
- a programmed processor: (see at least pages 1-2 ¶ 0012, page 3 ¶ 0032).

Pertaining to system claims 20-26

Rejection of system claims 20-26 is based on the same rationale as noted above.

(10) Response to Argument

I. Whether claims 10 and 20 are properly rejected under 35 USC §102(b) as

being anticipated by Published Application No. 2001/0005829 (Raveis).

Applicants remark at page 6 of the Brief that claims 10 and 20 recite “a method and computer system relating to facilitating a deal related to mortgage refinancing.” (See Brief page 6 lines 7-8). This is also noted in the preamble to the claims. The recitation in the preamble to the claims has not been given patentable weight, not only because it occurs in the preamble, but because it contains no functional method steps or system elements. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for

completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hiraio*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

It should be noted that the claims do not contain any active step involved in the refinancing process other than providing selected information to the parties involved in the transaction. No step towards the actual completion of a transaction takes place in the method (or the system). Thus it is Examiner's position that any prior art that provides selected information represents essentially the same invention. In the present case, however, the prior art discloses substantially the same type of information, information relating to real estate transactions. Applicants attempt to portray the information itself as a step in the method. It is Examiner's position that the information is not a step in the method, however, despite this position, the Examiner also notes throughout the grounds of rejection that even if it were, the information provided in the prior art is essentially the same subject matter.

Applicants then contrast their claims with Gulack, the legal precedent cited with regard to nonfunctional descriptive information, rather than with *Raveis*, the prior art cited in this case. Applicants state that their claims recite "searching operations, retrieving operations and displaying operations." These features are clearly disclosed in *Raveis* as noted above under "Grounds of Rejection."

Applicants proceed to direct their remarks to the information contained within the data, arguing that the specific information contained within the data is itself a limitation, however it is noted that the data is claimed as "comprising" the information, indicating

that the information contained within the data is itself open ended and not in fact limited to the specific information identified in the claims and argued in Applicants' remarks.

Appellants mischaracterize Examiner's treatment of the claim language by stating that all elements accompanying the term "data" have been ignored. This is clearly incorrect as shown by a simple reading of the "Grounds of Rejection." For example, the step of "searching a database for data" is disclosed by the prior art as noted above.

Applicants remark that their interface has "three user actuatable buttons, each actuated by a single user selection, which result in the search for and retrieval of deal information specifically related to a selected real property...," and that this is not disclosed in the prior art. What Applicants are describing is a display page with three links to three different searches. This is old and well known in the art and is described in the prior art reference. The button feature is variously described as among other things, a bookmark, or a link. Raveis describes a number of different links to a wide range of information. Each of the links described is a separately user actuatable button, accessed by a single user selection, which promptly takes the user from a single display screen to the respective desired information. Although the Applicants appear to be arguing that their claims are limited to only three links and only three sets of information, the use of the term "comprising" in Applicants' claims indicates that the invention is not limited to only three links. The fact that Raveis discloses additional links to additional information is therefore irrelevant and made even more so because there is nothing in

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the prior art that would prevent the invention of Raveis from being limited to only three links if doing so were desirable in a particular instance of its use.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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